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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,119	12/21/1998	ANDREW M. PROEHL	80398-P158	3529

7590

04/10/2003

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EXAMINER

LONSBERRY, HUNTER B

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 04/10/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/218,119

Applicant(s)

PROEHL ET AL.

Examiner

Hunter B. Lonsberry

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-18,21-33,36,37,43-52 and 58-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18,21-33,36,37,43-52 and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-18, 21-33, 36, 37, 43-48, 50-52, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,699,107 to Lawler in view of U.S. Patent 5,583,560 to Florin and U.S. Patent 5,659,653 to Diehl.

Regarding claims 11 and 43-45, Lawler discloses a program reminder system in Figures 4 and 6, in which a user selects a TV program from a program guide which they wish to view at a later date via remind button 140 or cancel button 132, the program guide provides descriptive information on the program, five seconds before the program's start time a reminder is generated in a window which is placed over the currently watched program (Figure 9, column 12, lines 35-43, 53-63). Lawler does not disclose a system in which the reminder notification appears during a commercial advertisement or storing the reminder information locally. Diehl discloses a system in which a user presses a learn button during an advertisement for an upcoming broadcast of a program that the user is interested in, by pressing the learn button, CPU 29 queries TV 16 and Data Extractor 12 retrieves the program information and transfers it to the CPU, the VCR then programs itself to record the program (column 4, lines 10-column 5, line 33). Florin discloses a system in which a flashing icon 400 appears on a TV screen

(Figure 44) during an advertisement which when selected provides more information to the user regarding the advertised product (column 23, line 45-column 24, line 20).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler to use the on screen icon of Florin for selecting a program viewing reminder and indicating interest in a program during an advertisement for an upcoming broadcast, storing that information locally, retrieving program information and issuing a record command, as taught by Diehl for later viewing thus providing a number of impulse program choices to a user.

Regarding claim 12, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9); the user can then tune to the program action button 70 if they are interested in viewing the program (column 12, lines 35-43, 53-63, column 13, lines 1-6).

Regarding claim 13, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9, column 12, lines 35-43, 53-63).

Regarding claim 14, Lawler discloses in Figure 2 an action key 70 that is used by a subscriber to select a television program (column 13, lines 1-6).

Regarding claim 15, see claim 14.

Regarding claim 16, Lawler discloses in Figure 2 an action key 70 that is used by a subscriber to select a television program and tunes to the proper channel (column 13, lines 1-6).

Regarding claim 17, see claim 13.

Regarding claim 18, Lawler discloses in Figure 2 an action key 70 that is used by a subscriber to select a television program (column 13, lines 1-6).

Regarding claim 21, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9); the user can then tune to the program action button 70 if they are interested in viewing the program (column 12, lines 35-43, 53-63, column 13, lines 1-6). Lawler does not disclose a system in which the reminder notification appears during a commercial advertisement or storing the reminder information locally. Diehl discloses a system in which a user presses a learn button during an advertisement for an upcoming broadcast of a program that the user is interested in, by pressing the learn button, CPU 29 queries TV 16 and Data extractor retrieves the program information and transfers it to the CPU, the VCR then programs itself to record the program (column 4, lines 10-column 5, line 33). Florin discloses a system in which a flashing icon 400 appears on a TV screen (Figure 44) during an advertisement which when selected provides more information to the user regarding the advertised product (column 23, line 45-column 24, line 20). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler to use the on screen icon of Florin for selecting a program viewing reminder and indicating interest in a program during an advertisement for an upcoming broadcast, storing that information locally, retrieving program information and issuing a record command, as

taught by Diehl for later viewing thus providing a number of impulse program choices to a user.

Regarding claim 22, Lawler discloses in Figure 9, a program reminder system that superimposes a program-viewing window over the currently watched program.

Regarding claims 23 and 24, Lawler discloses in Figure 9, a program reminder system that displays a TV program reminder in a window prior to the beginning of a program and switches to a reminded program (column 12, lines 35-43, 53-63, column 13, lines 1-6)). Lawler also discloses in Figures 6 a program guide (Figure 6) with a remind button 140 and cancel button 132. The combined system of Lawler, Florin and Diehl does not disclose a reminder system, which includes a button in the notification window, but instead utilizes a button 70 on the remote control when then tunes to the program with the reminder (column 13, lines 1-6). Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Lawler, Florin and Diehl to display a button to indicate interest instead pressing a button on the remote control thereby reducing the number of buttons on a remote control and increase usability of the system

Regarding claim 25, Lawler discloses a program reminder system, which provides a second reminder five seconds before the program's start time; the user can then tune to the program (column 12, lines 35-43, 53-63).

Regarding claim 26, Lawler discloses in Figure 2, a video display 20 and in Figure 9, a reminder notification 152 overlaid on a TV program.

Regarding claim 27, Lawler discloses in Figure 9, a program reminder system that displays a TV program reminder in a window prior to the beginning of a program and tunes to the program once a user presses a button 70 on the remote control (column 13, lines 1-6).

Regarding claim 28, Lawler discloses that the user presses a button 70 on the remote control to tune to the programming (column 13, lines 1-6).

Regarding claim 29, Lawler discloses that the user presses a button 70 on the remote control to tune to the programming (column 13, lines 1-6), and analog or digital decoder is used to tune and decode the picture (column 6, lines 7-23).

Regarding claim 30, Lawler discloses a program reminder system that displays a reminder to a user several minutes before each designated program is to start (column 12, lines 53-63).

Regarding claim 31, Lawler discloses in Figure 6, a program guide with a reminder button 140 which a user uses to create a future program reminder event (column 13, lines 7-16).

Regarding claim 32, Lawler discloses in Figure 6, a program guide calendar which a user may use to set a reminder to watch a show in the future by pressing a remind button 140.

Regarding claim 36, Lawler discloses a program reminder system in Figures 4 and 6, in which a user selects a TV program from a program guide which they wish to view at a later date via remind button 140 or cancel button 132, the program guide provides descriptive information on the program, five seconds before the program's start

time a reminder is generated in a window which is placed over the currently watched program (Figure 9, column 12, lines 35-43, 53-63). Lawler does not disclose a system in which the reminder notification appears during a commercial advertisement or storing the reminder information locally. Diehl discloses a system in which a user presses a learn button during an advertisement for an upcoming broadcast of a program that the user is interested in, by pressing the learn button, CPU 29 queries TV 16 and Data extractor retrieves the program information and transfers it to the CPU, the VCR then programs itself to record the program (column 4, lines 10-column 5, line 33). Florin discloses a system in which a flashing icon 400 appears on a TV screen (Figure 44) during an advertisement which when selected provides more information to the user regarding the advertised product (column 23, line 45-column 24, line 20). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler to use the on screen icon of Florin for selecting a program viewing reminder and indicating interest in a program during an advertisement for an upcoming broadcast, storing that information locally, retrieving program information and issuing a record command, as taught by Diehl for later viewing thus providing a number of impulse program choices to a user.

Regarding claim 37, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9); the user can then tune to the program action button 70 if they are interested in viewing the program (column 12, lines 35-43, 53-63, column 13, lines 1-6).



Regarding claim 46 and 58, Lawler discloses in Figure 2, a CPU 58 inside of STB 18 which controls display 20 (column 5, lines 58-column 6, line 6).

Regarding claims 47, 48, 59 and 60, Lawler discloses that the STB is controlled via an IR remote control 22 (column 5, lines 58-column 6, line 6). Remote control 22 inherently contains a processor in order to interpret user input into commands to transmit via the infrared spectrum.

Regarding claim 50, Lawler discloses in Figure 2, a CPU 58 inside of STB 18 which controls display 20 (column 5, lines 58-column 6, line 6).

Regarding claims 51 and 52, Lawler discloses that the STB is controlled via an IR remote control 22 (column 5, lines 58-column 6, line 6). Remote control 22 inherently contains a processor in order to interpret user input into commands to transmit via the infrared spectrum.

Claims 49 and 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,699,107 to Lawler in view of U.S. Patent 5,583,560 to Florin and U.S. Patent 5,659,653 to Diehl in further view of U.S. Patent 5,990,927 to Hendricks.

Regarding claim 49, Lawler discloses in Figure 2, a set top box 18 with an analog decoder 42 for decoding broadcast TV, a network communication interface 56 for decoding control signals from the headend, a CPU 58 which delivers or requests information to/from the headend and controls selection of programming as well as the program guide (column 6, lines 7-31) column 7, lines 8-16). Hendricks discloses a EPG and reminder system which retrieves program information from the headend, a user

selects a program which they wish to record (Figure 15), the recording information is stored locally to later be sent to a VCR, prior to the recording time a reminder screen (Figure 22) is displayed (column 33, lines 34-58, column 40, lines 55-column 41, line 60). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler/Florin/Diehl to store the reminder information locally and be able to select programming to record as taught by Hendricks thereby allowing a user to impulse select a program to view.

Regarding claim 57, Lawler discloses in Figure 2, a set top box 18 with an analog decoder 42 for decoding broadcast TV, a network communication interface 56 for decoding control signals from the headend, a CPU 58 which delivers or requests information to/from the headend and controls selection of programming as well as the program guide (column 6, lines 7-31) column 7, lines 8-16). Diehl discloses storing a record request locally (column 4, lines 10-column 5, line 33). Lawler, Diehl and Florin do not disclose displaying a 2<sup>nd</sup> notification to record prior to the start time of the broadcast. Hendricks discloses a EPG and reminder system which retrieves program information from the headend, a user selects a program which they wish to record (Figure 15), the recording information is stored locally to later be sent to a VCR, prior to the recording time a reminder screen (Figure 22) is displayed (column 33, lines 34-58, column 40, lines 55-column 41, line 60). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler/Florin and Diehl to transmit a second notification prior to the recording start time to make sure that a video tape is loaded into the VCR to record on.

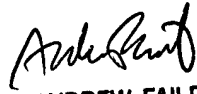
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 703-305-3234. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5359 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

HBL  
March 26, 2003

  
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